

REMARKS/ARGUMENTS

Claims 1-30 and 34-35 are pending herein. Claims 31-33 have been cancelled. New independent claim 34 has been added, as supported by original specification paragraphs [0029]-[0030] and [0053], for example. New independent claim 35 has been added, as supported by original specification paragraphs [0047]-[0050], for example. Independent claims 1, 25 and 29 have been amended to clarify that the invention claimed is an apparatus. Claims 2, 4, 5, 7, 9, 10, 16, 17 and 25-29 have been amended to correct matters of form. Applicant respectfully submits that no new matter has been added.

1. Applicant respectfully traverses the Examiner's statement that a certified copy of the 2000-245861 application has not been filed with the USPTO. A certified copy of JP '861 was filed with the claim for priority on January 16, 2001. Attached as Appendix A is a copy of the claim for priority and postcard receipt. Applicant respectfully requests that the Examiner withdraw this statement.

2. Claims 1-24 were rejected under §112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter of the claimed invention. However, Applicant notes that under the PTO's guidelines, a claim is considered deficient under §112, second paragraph only when either (1) evidence shows applicant has stated that he or she regards the invention to be different from what is claimed, or (2) the scope of the claims is unclear. There is nothing in the present application to indicate the inventor believes the invention to be different from what is claimed and, similarly, nothing to indicate the scope of the claims is unclear. Applicant respectfully submits that the original claims complied with these requirements. However, in response to the Examiner's rejection, the text of the claims has been amended to more distinctly claim the apparatus of the present invention. After the amendment, the pending claims now more clearly point out and distinctly claim the apparatus of the claimed invention and are in allowable form.

3. Claims 1-33 were rejected under 35 USC §101 because the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner stated the claims only recite an abstract idea. Applicant has amended claims 1, 25 and 29 to clarify that the information is input into an apparatus and that the charge calculating means is included in the apparatus. After incorporating this clarification amendment, Applicant respectfully submits that the pending claims clearly define statutory subject matter.

Process claim 31 is hereby cancelled and replaced with new claim 34. New claim 34 is added to recite the process claim language in conformance with process claim type (2) (the claim language must be limited to a practical application in the technological arts if there is no recitation of a physical transformation step or if the claimed process steps merely manipulate concepts or convert one set of numbers into another), as discussed in the PTO's Examination Guidelines for Computer-Related Inventions, final version, section IV(B)(2)(b) on page 15. New claim 34 clearly defines statutory subject matter.

Recording medium claim 32 and pending computer program claim 33 are hereby cancelled and replaced with new claim 35. New claim 35 is added to recite the functional requirements of claims 32 and 33 in the means-plus-function format of 35 USC §112 paragraph 6. New claim 35 clearly defines statutory subject matter.

4. Claim 1 was rejected under §102(b) over McGuire et al. In response to the Examiner's rejection, applicant has amended claim 1 to recite the functions of the apparatus of claim 1 in the means-plus-function format of 35 USC §112 paragraph 6. In accordance with MPEP §2182, for a prior art reference to anticipate a means-plus-function claim, the reference must teach an element that performs the identical function specified in the claim and the structure of the prior art element must be the same as or equivalent to the structure described in the specification which corresponds to the claimed means-plus-function limitation. Further, in accordance with MPEP §2184, one of the factors to be considered in deciding structural equivalence is

whether the prior art element performs the function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification. The cited McGuire reference discloses a system, which calculates the state and local tax charges associated with automobile repairs, and then generates an invoice for the total amount due. However, as acknowledged by the Examiner in the office action, mailed December 8, 2004, McGuire does not disclose or suggest a charge calculating device for calculating introduction expenses of facilities required for working as a franchisee providing automobile repairing services by a specific repairing method, as is claimed here. Thus, it is clear that McGuire does not disclose or suggest a function identical or equivalent to the function of calculating introduction expenses for franchisees as specified in claim 1. Additionally, while applicant recognizes the PTO's case law citations, applicant believes that the cited cases, which deal with non-computer-related inventions and predate the PTO's publication of the Guidelines for Computer-Related Inventions, are not relevant with respect to the present invention. Applicant respectfully submits that the amendment distinguishes claim 1 from the McGuire reference and claim 1 is believed allowable over the applied art.

5. Claims 2-3 and 17-24 were rejected under §103(a) over McGuire in view of Sigmund J. Mikolajczyk, *Too good to be true?* article, Tire Business, p14 (August 5, 1996).

As previously discussed, the McGuire reference discloses a device for estimating the costs of services provided at a service station, including state and local taxes, and generating an invoice. The "*Too good to be true*" article discusses some of the advantages and disadvantages of operating a business as a franchisee, including the quoted support provided under the Goodyear and TWC programs, but does not disclose or suggest calculating introduction expenses required for facilities to work as a franchisee providing automobile repairing services by a specific method. In fact, the article actually discusses various franchisee benefits, including selling auto parts with

three different service options: cash and carry, semi-self-service and full service under a particular company's franchise agreement, but does not disclose how franchise expenses are calculated. It is well established that in deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art. "That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." (*In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966)). In the cited referenced, franchisee variables, including repair instruments and inventory management, are discussed in general terms, but neither reference discloses, teaches or suggests, as stated in the office action, a customized franchisee business system, where the charge information processing apparatus of the present invention, includes the means for calculating instruction fees, managing franchisee information, managing branch plan information and sales estimation, among other means disclosed in the application. A retrospective view of inherency is not a substitute for some teaching or suggestion, which supports the selection and use of the various elements in the particular claimed combination. *In re Newell*, 13 USPQ2d 1248, 1250 (CAFC)(citing *SmithKline Diagnostics v. Helena Laboratories Corp.*, 859 F.2d 878, 886-87, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988)). Thus, neither of the cited references, alone nor in combination, discloses any apparatus, which renders the present invention obvious. Applicant respectfully requests that the above rejection be reconsidered and withdrawn.

6. Claims 25-33 were also rejected under §103(a) over Maguire in view of "*Too good to be true?*" article.

With respect to independent claims 25 and 29, the analysis discussed under the PTO's asserted rejection of pending claim 1 over Maguire applies to these claims as well. Similarly, the conclusion that McGuire does not disclose or suggest a function identical or equivalent to the function of calculating introduction expenses for franchisees also applies to independent claims 25 and 29 and dependent claims 26-28 and 30 which depend therefrom. Claims 31-33 are cancelled. For the reasons

discussed above, neither of the cited references, alone nor in combination, discloses any apparatus, which renders the present invention obvious. Applicant respectfully requests that the above rejection be reconsidered and withdrawn.

With respect to new claim 34, this rejection does not apply because McGuire does not appear to disclose steps of inputting scale information of an automobile repair shop and calculating the introduction expenses based on the previously entered scale information and stored charge calculation data. Similarly, with respect to new claim 35, there is no disclosure or suggestion in Maguire of a program on a recordable medium capable of accepting and storing scale information and calculating introduction expenses based on the stored scale information and charge calculation base data.

7. Claims 4-10 were rejected under §103(a) over Maguire in view of *Too good to be true?* article, and in further view of Sherman, Andrew J., *Hard data on franchises* article, (*Federal Trade Commission's Uniform Franchise Offering Circular*), Nations Business, v82, n2, p54 (1)(Feb. 1994).

With respect to claims 4 and 5, the language of claims 4 and 5 were amended to replace the non-functional language and further clarify the claimed invention. Additional amendments to clarify what was being claimed were incorporated into claims 4-5, 7, and 9-10. Minor punctuation errors were also corrected in claims 7-8. With respect to claims 4-10, it should be noted that none of the cited prior art references teaches or suggests a charge information processing apparatus that also calculates the instruction fee for the specific method of repair, which is disclosed in claim 3. Claims 4-10 depend directly or indirectly from claim 3 and therefore include all of the limitations of claim 3. The Examiner's comment concerning "slight damage" being non-functional descriptive language is traversed. As indicated in paragraph [0022], the repairing of slightly damaged automobiles is a method of conducting business separate from the repair of damaged automobiles. Applicant

considers the Examiner's comment concerning "slight damage" as moot. Applicant respectfully requests that the above rejection be reconsidered and withdrawn.

8. Claims 11-16 were rejected under §103(a) over Maguire in view of *Too good to be true?* article, in further view of *Hard data on franchises* article, and in further view of Tsutomu et al.

With respect to claims 11-16, as previously discussed, none of the cited prior art references teaches or suggests a charge information processing apparatus that also calculates the instruction fee for the specific method of repair, as disclosed in claim 3. Claims 11-16 depend directly or indirectly from claim 3 and therefore include all of the limitations of claim 3. Applicant respectfully requests that the above rejection be reconsidered and withdrawn.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.


Applicant respectfully requests that the PTO acknowledge receipt and consideration of the Information Disclosure Statement filed July 2, 2001.

If the Examiner believes that contact with Applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicant's attorney at the phone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-1446.

Respectfully submitted,

March 8, 2005
Date


Stephen P. Burr
Reg. No. 32,970

Joseph A. Wilson
Reg. No. 53,780

SPB/JAW/gh

Attachment: Appendix A - Copy of 1/16/01 Claim for Priority and postcard receipt

BURR & BROWN Customer No.: 025191
P.O. Box 7068
Syracuse, NY 13261-7068

Telephone: (315) 233-8300
Facsimile: (315) 233-8320